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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/922,210	08/03/2001	Sean Sanderlin	P-99996.886	7904

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EXAMINER

VIG, NARESH

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 11/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/922,210

Applicant(s)

SANDERLIN, SEAN

Examiner

Naresh Vig

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9 and 12-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9 and 12-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

This is in reference to response received 12 September 2006. Claims 9 and 12 – 14 are pending for examination.

### ***Election/Restrictions***

Applicant's election without traverse of claims 9 and 12 – 14 in the reply filed on 09 September 2006 is acknowledged.

### ***Response to Arguments***

Applicant's arguments and concerns are for newly added claims which have been responded to in response to pending claims below.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Clai9 and 12 – 14 are rejected under 35 U.S.C. 112, second paragraph, as being vague and indefinite because it is not clear whether transmission of said potential relationship data from said database to said terminals through said data transmission network is transmission to data to all of the plurality of terminals, or, only to all members and conflict administrator terminals.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9 and 12 – 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horwitz et al. US Patent 5,774,866 hereinafter known as Horwitz in view of Applicant's Admitted Prior Art hereinafter known as AAPA.

Regarding claims 9 and 12 - 14, Horwitz teaches computerized method for checking and clearing relationship problems in an organization. As acknowledged by the applicant "U.S. Patent No. 5,774,866, the '866 patent, describes a computerized system used to determine if a conflict of interest exists" [instant application, 0007]. Horwitz teaches:

providing a computer system having a central database connected to a plurality of through a data transmission network;

storing, upon database, computer intelligible existing relationship data denoting one or more existing parties being serviced by organization [Horwitz, Fig.1 and disclosure associated with Fig. 1];

storing, upon database, computer intelligible potential relationship data denoting one or more potential parties, potential relationship data inputted into one of terminals by a requesting party;

transmitting potential relationship data from database to terminals through data transmission network;

providing a visual indication upon terminals of all members that new potential relationship data is available for review (providing an indication of pending status accessible through the network for each proposed matter) [Horwitz, col. 4, lines 40-46];

Horwitz does not explicitly teach displaying potential relationship data upon terminals for review by all members. However, Horwitz teaches that Many law firms utilize computerized systems for the initial stages of a conflict checking process. AAPA teaches "Some law firms seek to avoid conflicts by circulating hard copy memoranda of potential new matters to all of their attorneys, so that each attorney can review all incoming clients and/or matters and voice any objections" [AAPA, 004]. It would have been obvious to one of ordinary skill in the art to modify Horwitz and electronically distribute memoranda of new matters to automate the content delivery. For example, distribution of documents in electronic format like MS-Work, PDF, email, broadcast etc. (In re Venner, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958))

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify teachings of Horwitz as taught by AAPA a process commercially in use at the time of invention of circulating memoranda of

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potential new matters to all of their attorneys to comply to Conflict Of Interest Systems Conversion Manual published by Attorney's Liability Assurance Society, Inc. (1991).

Horwitz in view of AAPA teaches:

providing a graphic user interface upon each of terminals for facilitating communication between members and requesting party;

receiving, upon terminals, response information concerning potential relationship data, response information directly entered by any one or more of members;

transmitting input information from terminals to requesting party and conflicts administrator through data transmission network;

actuating computer system to compare potential relationship data and existing relationship data;

identifying when potential relationship data matches existing relationship data;

creating an electronic report denoting one or more of data matches, or lack thereof;

transmitting report to conflicts administrator

transmitting report to requesting party; and

notifying requesting party of the status of potential client data.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 CFR '1.111 (c) to consider the references fully when responding to this office action.

#### **1. Implementing A Conflicts Control System**

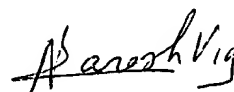
Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naresh Vig whose telephone number is (571) 272-6810. The examiner can normally be reached on M-F 7:30 - 6:00 (Wednesday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Naresh Vig  
Examiner  
Art Unit 3629

November 16, 2006